

Remarks

The Applicant affirms the election of the invention recited in claims 9-16 and 18. The Applicant has cancelled claims 1-8 subject to Applicant's right to file a divisional application for these claims. The Applicant has also entered a cancelled claim 17.

The Examiner rejected claims 9-13, 15-16, and 18 as being anticipated by JP 2001-63325 (hereinafter Japan 325). The Examiner rejected claims 10-13 as being obvious in view of the combination of Japan 325 and EP 1049196 (hereinafter Europe 196). The Examiner rejected claims 10-11 and 14 as being obvious in view of the combination of Japan 325 and Lee (US 5,731,754) and/or EP 694,861 (hereinafter Europe 861). In view of these rejections, the Applicant has amended claim 9 to recite the relationship between the encapsulation material and the material of the tire sidewall. The Applicant submits claim 9 and new claim 19 are patentable over the art.

Japan 325 discloses a tire having a transponder that is built into the tire sidewall while the tire is manufactured. Japan 325 teaches that a transponder is placed into the tire mold where it is pressed into the sidewall of a green tire. The sidewall of the green tire is vulcanized around the transponder to secure the transponder in place. The transponder is thus fully exposed to the heat of the tire vulcanization process. The invention of claims 9 and 19 avoids this drawback by allowing the monitoring device to be placed into a sidewall cavity after the sidewall is vulcanized. The claimed invention thus allows the monitoring device to be securely connected to the tire without exposing the monitoring device to the heat used to vulcanize the tire. Instead of vulcanizing the tire around the monitoring device, an encapsulation material is used to secure the monitoring device in place. Japan 325 does not disclose the use of an encapsulation material that secures the transponder to the sidewall. The transponder of Japan 325 is encapsulated and cured before being inserted into the tire mold. The Japan 325 encapsulation material is thus not used to secure the Japan 325 transponder in place. Japan 325 thus does not anticipate claims 9 and 19.

With respect to the obviousness rejections, the Applicant submits Japan 325 teaches away from the claimed invention and thus does not provide the suggestion or motivation necessary for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestions or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142. The teachings of Japan 325 would lead one of ordinary skill in the art away from the invention recited in claim 9 and 19. Japan 325 teaches that the transponder is to be encapsulated and cured prior to be inserted into a tire mold where a green tire is cured around the transponder to capture the transponder. The Japan 325 reference thus does not provide the requisite suggestion or motivation for securing a tag into a sidewall cavity with an adhesive connection created by the encapsulation material because Japan 325 teaches the use of a mechanical interconnection of elements formed during the tire cure process. The Applicant submits there is no reason to combine the teachings of the secondary references with the Japan 325 reference given the direction of the Japan 325 teachings. The Examiner cited the secondary references to disclose different types of encapsulation materials. Regardless of the types of materials known in the art, the Applicant submits Japan 325 does not provide a suggestion for one of ordinary skill in the art to use an encapsulation material to create a tire such as that recited in the claims wherein the encapsulation material is used to hold the tag within the sidewall cavity.

The Applicant has added new claims 19-26 and respectfully requests the claims to be examined. In view of the foregoing, the Applicant respectfully

requests reconsideration of the claims and most earnestly solicits the issuance of a formal Notice of Allowance for the claims.

Please call the undersigned attorney if any issues remain after this amendment.



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I hereby certify that this correspondence (Amendment A in application serial no. 10/743,694 filed 12/22/2003) is being deposited with the United States Postal Service as first class mail (with sufficient postage) in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, OR is being transmitted by facsimile to 571-273-8300 on December 27, 2005.



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